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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,961	09/29/2006	Toru Maeda	070456-0154	5771

20277 7590 03/30/2009

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EXAMINER	
SHEEHAN, JOHN P	

ART UNIT	PAPER NUMBER
1793	

MAIL DATE	DELIVERY MODE
03/30/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/594,961	MAEDA ET AL.	
	Examiner	Art Unit	
	John P. Sheehan	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/29/2006 12/10/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. Claim 7, line 2, recites, "performing a second heat treatment of said compact" (emphasis added by the Examiner). This claim is indefinite in that the phrase, "a second heat treatment" implies that there was a first heat treatment of the compact, however neither claims 5 or 1 from which claim 7 depends recite a first heat treatment of the compact. In view of this, it is not clear whether and when the compact was heat treated the first time.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Satsu et al. (Satsu ‘219, US Patent No. 6,054,219, cited in the IDS submitted December 10, 2008).

Satsu '219 teaches a soft magnetic powder. The disclosed soft magnetic powder is coated with an insulating layer and subsequently pressure formed to form a dust core which is heat treated (Example 1, column 9, line 38 to column 10, line 30).

The claims and Satsu '219 differ in that Satsu '219 does not teach all of the same process steps as recited in applicants' product by process claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the process steps recited in applicants' product by process claims are substantially similar to the process steps taught by Satsu '219 and any difference(s) in process steps do not necessarily lend patentability to the claimed product, MPEP 2113.

> "[E]ven though product-by-process claims are lim - ited by and defined by the process, determination of patentability is based on the product itself. The patent- ability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe* ,777 F.2d 695,698,227 USPQ 964,966 (Fed. Cir.1985.

It is noted that the use of a rejection under 35 USC 102/103 for product by process claims as set forth above has been approved by the courts, see MPEP 2113.

> "[T]he lack of physical description in a product-by- process claim makes determination of the patentabil - ity of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art dis - closes a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown* , 459 F.2d 531,535,173 USPQ 685,688 (CCPA 1972).

Claim Rejections - 35 USC § 103

7. Claims 1 to 3 and 5 to 7 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Satsu '219 in view of Takashi et al. (Takashi '602, Japanese Patent Document 63-121602, cited in the IDS submitted September 25, 2005).

Satsu '219 teaches and is applied as set forth above. Additionally, Satsu '219 teaches specific example particle sizes of 70 and 100 microns that are encompassed by the particle size range of 10 to 400 microns recited in applicants' claim 2 (column 10, lines 11 and 18). Satsu '219 teaches that the magnetic powder is coated with an insulating layer and then pressed formed into a compact as recited in claim 5, (Example 1, column 9, line 38 to column 10, line 25). Prior to press forming Satsu '219 teaches adding a resin (organic matter) to the powder as recited in claim 6 (column 10, lines 20 to 25) and after press forming the powder heat treating the compacted powder at a temperature of 200 ^{0}C which is encompassed by the heat treatment recited in claim 7.

Takashi '602 teaches treating a magnetic powder with an acid (etching) to remove the surface layer of the magnetic powder and thereby removing the oxides and strain which would negatively affect the properties of the magnetic powder and subsequently heat treating the etched powder at a temperature of $\geq$ 500 ^{0}C as recited in the claims.

Satsu '219 and the claims differ in that Satsu '219 does not teach etching the magnetic powder.

However one of ordinary skill in the art at the time the invention was made would have been motivated to etch Satsu '219's powder so as to remove the oxides and strain in the powder and thereby improve the magnetic properties of Satsu '219's powder as taught by Takashi '902.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/
Primary Examiner, Art Unit 1793

JPS